

### **REMARKS**

Claims 7-12, 17-38 and 46-85 are pending in the above-captioned patent application following this amendment. The Applicants have amended the specification to avoid duplication. Claims 1-51 were rejected. The Applicants respectfully traverse the rejection of claims 3 (re-presented herein as claim 52), 4 (re-presented herein as claim 53), 6 (re-presented herein as claim 54), 7-12, 13 (re-presented herein as claim 55), 16 (re-presented herein as claim 56), 17-38, 41 (re-presented herein as claim 57), 42 (re-presented herein as claim 58), 45 (re-presented herein as claim 59) and 46-51. Claims 7-12 and 46-51 were amended to clarify what applicants regard as the invention, claims 1-6, 13-16 and 39-45 have been canceled without prejudice and new claims 60-85 have been added by this amendment for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000), even though the Applicants believe that the previously pending claims were allowable.

Support for the amendments to the claims and the new claims can be found throughout the originally filed application, including the originally filed claims, the drawings and the specification. More specifically, claims 7-12 have been amended to depend from claim 54, and claims 46-51 have been amended to depend from claim 59.

Support for new claims 60-85 can be found at least in claims 1-16 and 39-51, in Figures 2A-6C, and in the specification at page 2, line 23 through page 3, line 15, at page 3, lines 20-25, at page 5, lines 23-27, at page 6, lines 27-32, at page 7, lines 24-26, at page 8, lines 3-5, at page 10, line 5 through page 12, line 17, at page 13, lines 9-14, at page 13, line 27 through page 14, line 16, and at page 16, line 25 through page 18, line 11.

No new matter is believed to have been added by this amendment. Consideration of the Application is respectfully requested.

### **Rejections Under 35 U.S.C. § 102**

Claims 1, 2, 5, 14-15, 39-40 and 43-44 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mallery (US 6,307,719). Claims 1, 2, 5, 14-15, 39-40 and 43-44 have been canceled without prejudice by this amendment. Thus, the rejection of these

claims under 35 U.S.C. § 102(e) is believed to be moot.

### **Rejections Under 35 U.S.C. § 103**

Claims 3, 4 and 41-42 are rejected under 35 U.S.C. § 103 as being unpatentable over Mallary (US 6,307,719). Claims 6-13, 16-38 and 45-51 are rejected under 35 U.S.C. § 103 as being unpatentable over Mallary in view of Simmons et al. (US 5,742,452).

### **Common Ownership:**

"Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.'" MPEP 706.02(I)(1).

The present application and Mallary (US 6,307,719) were, at the time the invention disclosed in the present application was made, owned by Maxtor Corporation. As provided above, Mallary should be excluded from use as prior art in a rejection under 35 U.S.C. § 103.

Claim 3 has been re-presented as claim 52; claim 4 has been re-presented as claim 53; claim 6 has been re-presented as claim 54; claim 13 has been re-presented as claim 55; claim 16 has been re-presented as claim 56; claim 41 has been re-presented as claim 57; claim 42 has been re-presented as claim 58; and claim 45 has been re-presented as claim 59.

Therefore, the Applicants respectfully submit that the rejection by the Patent Office under 35 U.S.C. § 103 of claims 7-12, 17-38 and 46-59 is improper and should be withdrawn. Accordingly, claims 7-12, 17-38 and 46-59 are believed to be allowable.

### **New Claims**

New claims 60-85 have been added by this amendment. New claims 60-85 are of a slightly different scope than the previously pending claims. However, in view of the cited references, new claims 60-85 are believed to be patentable.

New claim 60 is directed toward a disk drive that requires "a drive housing; a drive circuitry; and a head arm assembly coupled to the drive housing, the head arm assembly including (i) a load beam that is electrically isolated from the drive circuitry, (ii) a slider that is connected to the drive circuitry, the slider being supported by the load beam, and (iii) an adjuster that is coupled to the load beam, the adjuster adjusting the gram load applied to the slider based on the temperature of the adjuster." In view of the cited references, new claim 60 is considered to be patentable. Because claims 61-73 depend directly or indirectly from claim 60, they are likewise considered to be patentable.

Further, new claim 74 is directed toward a method requiring the steps of "coupling the slider to a load beam that is electrically isolated from a drive circuitry; and adjusting the gram load applied to the slider with an adjuster that moves based on the temperature of the adjuster so that the slider is maintained within the desired flying height range." In view of the cited references, claim 74 is believed to be patentable. Because claims 75-85 depend directly or indirectly from claim 74, they are also believed to be patentable.

#### **Remaining Reference**

The reference cited by the Examiner, but not relied on for the rejection of claims, has been noted. The remaining reference is no more pertinent than the applied references, therefore, a detailed discussion of this remaining reference is deemed unnecessary for a full and complete response to the Office Action.

### Conclusion

In conclusion, Applicants respectfully assert that claims 7-12, 17-38 and 46-85 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-672-0454 for any reason that would advance the instant application to issue.

Dated this the 20<sup>th</sup> day of November, 2003.

Respectfully submitted,



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